

REMARKS

Claims 1-32 were presented for examination and are pending in this application. Claims 1-11, 20, 29, and 30 were elected. Claims 12-19, 21-28, 31, and 32 stand withdrawn without prejudice.

The Examiner rejected claims 1, 2, 7, 8, 20, and 29-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,797,089 to Nguyen (hereinafter Nguyen); rejected claims 3-5 under 35 U.S.C. § 103 as being unpatentable over Nguyen in view of U.S. Patent No. 6,662,244 to Takahashi (hereinafter Takahashi); rejected claim 6 under 35 U.S.C. § 103 as being unpatentable over Nguyen in view of Takahashi and U.S. Patent Application Publication 2001/00272121 of Boesen (hereinafter Boesen); rejected claims 9-11 under 35 U.S.C. § 103 as being unpatentable over Nguyen in view of Boesen.

Section 102 under Nguyen

The Examiner rejected claims 1, 2, 7, 8, 20, and 29-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,797,089 to Nguyen (hereinafter Nguyen). Applicants disagree with this rejection. Claims 1, 7, 20, 29, and 30 are independent claims.

Claim 1 as amended recites:

1. A method for operating a personal digital assistant (PDA), the PDA including a lid, a power button that activates the PDA, a processor, a memory, and a plurality of applications stored in the memory, the method comprising:
 - responsive to the lid being opened, activating the PDA and executing by the processor a first application stored in the memory of the PDA; and
 - responsive to activation of the PDA power button when the lid is closed, activating the PDA and executing by the processor a second application stored in the memory of the PDA.

Thus, there are two ways to turn on the PDA when its lid is closed:

- 1) by flipping open the lid, or

2) by pushing a PDA power button (when the lid is still closed).

Note that turning on the PDA is not the same as turning on the phone/radio.

In contrast, Nguyen shows a device that operates only as a phone when its lid is closed (see, e.g.,). The lid must be open for the device of Nguyen to operate as both a PDA and a phone.

Nguyen has a telephone power switch 13 on the outside of its case and two power buttons 25 and 26, respectively for phone and PDA, on the inside of its case. Nguyen does not have a PDA power button on the outside of its case, only on the inside. Furthermore, the PDA of Nguyen only operates when its case is open. Thus, Nguyen completely fails to disclose or suggest the method of claim 1, including “responsive to activation of the PDA power button when the lid is closed, activating the PDA...” Claim 1 and its dependent claims patentably distinguish over Nguyen for at least this reason.

Independent claims 29 and 30 are patentable for at least the same reasons.

New claim 34 recites that the applications that run when the PDA is powered up (either by opening the lid or by pushing a power button) are user-assignable. There is no disclosure or suggestion in Nguyen that the application that runs when the phone or PDA is turned on is user-assignable.

New claim 44 recites that there are two ways to activate the phone application:

- 1) by flipping open the lid (automatically goes into phone mode by default), or
- 2) by pushing a PDA power button (when the lid is still closed).

Note that activating the phone application is not the same as turning on the phone/radio.

Independent claim 7 recites:

7. A method for operating a personal digital assistant (PDA), the PDA including a lid, at least one application button, a processor, a memory, and a plurality of applications stored in the memory, the method comprising:

responsive to the lid being opened, activating the PDA and executing by the processor a first application stored in the memory of the PDA; and

responsive to activation of one of the application buttons when the lid is closed, activating the PDA and executing by the processor a second application stored in the memory of the PDA, the second application associated with the activated application button.

Nguyen does not disclose or suggest the accessible application buttons when its lid is closed.

Therefore, claim 1 patentably distinguishes over Nguyen for at least this reason.

Independent claim 20 recites:

20. A method for operating a personal digital assistant (PDA), the PDA including a lid, a wireless communication module, a processor, a memory, and a plurality of applications stored in the memory, the method comprising:

determining that the lid has been opened;

responsive to the lid having been opened:

turning on the PDA; and

automatically launching a phone application.

When the lid of Nguyen is opened, the device enters PDA mode. In order to then enter a phone mode, the user must press a phone button (col. 5, lines 46-67). Therefore, claim 1 patentably distinguishes over Nguyen for at least this reason.

Section 103 over Nguyen and Takahashi

The Examiner rejected claims 3-5 under § 103 as being unpatentable over Nguyen in view of Takahashi . Applicants disagree with this rejection.

Independent claim 4 recites:

4. A method for operating a personal digital assistant (PDA), the PDA including a lid, a jog rocker, a processor, a memory, and a plurality of applications stored in the memory, the method comprising:

responsive to the lid being opened, activating the device and executing by the processor a first application stored in the memory of the PDA; and

responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA.

The Examiner admits that Nguyen fails to disclose or suggest a jog rocker and relies on the alleged teaching of a jog rocker in Takahashi. Applicants do not address herein the issue of whether a jog rocker is the same as or equivalent to a jog dial. First, the Examiner's motivation for the suggested combination is based entirely on hindsight. The Examiner argues that motivation existed to add a jog rocker to Nguyen "in order to control the input display mode by means of a jog rocker." This is circular reasoning. There is no motivation provided by either Nguyen or Takahashi. Nguyen operates without a jog rocker and the Examiner has failed to provide a reason why a person of ordinary skill in the art would have been motivated to add one at the time the invention was made. Nguyen includes an optional trackball 29, and it seems redundant to add a jog rocker besides.

Section 103 over Nguyen, Takahashi and Boesen

The Examiner rejected claim 6 under § 103 as being unpatentable over Nguyen in view of Takahashi and Boesen. Applicants disagree with this rejection. Dependent claim 6 depends from claim 4 and is patentable for at least the same reasons as claim 4 discussed herein.

Section 103 over Nguyen and Boesen

The Examiner rejected claims 9-11 under § 103 as being unpatentable over Nguyen in view of Boesen. Applicants disagree with this rejection. The Examiner admits that Nguyen fails to

disclose or suggest a method including: “responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application.”

The Examiner contends that this element is found in Boesen and that a person of ordinary skill in the art would have been motivated to combine the documents “in order to notify a person of appointments or incoming messages.” Applicants disagree with the Examiner’s contention that the documents disclose what the Examiner says they do. But in any case, the Examiner’s motivation is based solely on hindsight. Nguyen has a working telephone in the device without opening the case and without causing the pda portion of the device to turn on. There is no reason why an alarm would have to sound in Nguyen because Nguyen has a phone ringer (see element 63 of Fig. 4, which states that the phone operates like a standard mobile phone when the case is closed.)

Claims 10-11, which depend from claim 9, are patentably distinct for at least the reasons discussed with claim 9 above.

Conclusion

Applicants respectfully submit that claims 1-11, 20, 29, and 30 as presented herein, patentably distinguish over the cited reference (including references cited, but not applied). Therefore, Applicants request reconsideration and allowance of these claims.

In addition, Applicants respectfully invite the Examiner to contact Applicants’ representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,
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PATENT

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